

REMARKS

Applicants have carefully studied the outstanding Office Action. The present amendment is intended to place the application in condition for allowance and is believed to overcome all of the objections and rejections made by the Examiner. Favorable reconsideration and allowance of the application are respectfully requested.

Applicants have amended claims **38, 39, 42 - 44** and **48** to more properly claim the present invention. No new matter has been introduced, and support for the claim amendments is provided hereinbelow. Claims **38 - 57** are presented for examination.

Claim Rejections – 35 U.S.C. §112

In paragraphs 7 and 8 of the Office Action, the Examiner has rejected claims **38 - 57** under 35 U.S.C. §112, first paragraph, as failing to comply with the description requirement.

Specifically, the Examiner has pointed out that claims **38** and **48** include the limitation that “*the control mark cannot be changed or removed by the document word processor*”, whereas the specification indicates that “*Mark Scanner Module 160 checks the control mark to ensure that it is intact and has not been tampered with*”. Applicants respectfully submit that the claimed control mark cannot be changed by the document word processor (e.g., Microsoft Word), but it can be tampered with by other means (e.g., a tool that edits binary files).

In order to further clarify this feature, applicants have amended claims **38** and **48** to recite that the control mark cannot be changed or removed by means of the document word processor.

As such, applicants respectfully submit that the Examiner’s Response to Arguments in paragraph 5 of the Office Action is

rendered moot, and respectfully request that the Examiner reconsider applicants' arguments.

In paragraphs 9 and 10 of the Office Action, the Examiner has rejected claims **38 – 57** under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended these claims to clarify the ambiguities suggested by the Examiner.

Claim Rejections – 35 U.S.C. §103

In paragraphs 11 - 23 of the Office Action, the Examiner has rejected claims **38 – 57** under 35 U.S.C. §103(a) as being unpatentable over Ng, U.S. Patent No. 6,640,301 ("Ng") in view of Shaikh, U.S. Patent No. 7,035,830 ("Shaikh").

The prior art of Ng was discussed in applicants' response filed on March 5, 2010. The prior art of Shaikh was discussed in applicants' response filed on February 18, 2011.

It appears that the Examiner has overlooked applicants' argument that there is no motivation for combining Shaikh with Ng

In the response filed on February 18, 2011, applicants pointed out that there is no motivation for combining Shaikh with Ng. Indeed, Ng relates to authentication of e-mail and, in distinction, Shaikh relates to electronic filing of documents. It is only the result of impermissible hindsight, based on applicants' disclosure, that the Examiner has combined Shaikh with Ng.

In paragraph 3 of the Office Action, the Examiner has indicated that applicant's arguments filed on February 18, 2011 are moot in view of the new grounds of rejection. However, applicants argued there that there is no motivation for combining Shaikh with Ng, and yet the Examiner has again combined these prior art references, without

addressing applicants' concerns. Despite the new grounds of rejection, applicants' arguments in this regard are not moot.

In paragraphs 24 - 35 of the Office Action, the Examiner has rejected claims **38** - **57** under 35 U.S.C. §103(a) as being unpatentable over Ng, U.S. Patent No. 6,640,301 ("Ng") in view of Levy, U.S. Publication No. 2004/0001606 A1 ("Levy").

Levy describes use of watermarking fonts to embed hidden messages in text documents. Each character in a font set has two character codes, a first code in the range 0 - 127 corresponding to a first representation of the character, and a second code in the range 128 - 255 corresponding to a second representation of the character, as shown in FIG. 3 of Levy. A message in the form of a binary string is embedded by encoding a bit within a character code in accordance with the representation used for the character (Levy/ paragraphs 0008, 0011 and 0034; step 204 of FIG. 5). E.g., referring to FIG. 3 of Levy, the binary string "101100" can be embedded in the character string "Patent" by designating character codes 80-225-116-101-238-244. First representations, correspond to a "1" bit, are used for characters "P", "t" and "e", and second representations, corresponding to a "0" bit, are used for characters "a", "n" and "t".

Levy's embedded message is extractable from both a text version and a rasterized image version of the document (Levy/ paragraphs 0033, 0084 and 0085).

A consequence of the encoding of Levy is that if the text in the document is changed, then the binary string must be re-embedded in the document. Referring to the example above, if the text "Patent" is changed to "Office", then the binary string "101100" must be re-embedded by designating changed character codes 79-230-102-105-227-229. In order to avoid such re-embedding, Levy performs the character

code modification (i.e., the embedding) at the end, *"when the text of a document is saved to a file on persistent storage, or as the text document is sent to a print process"* (Levy/ paragraph 0081).

In distinction, the control mark of the claimed invention remains intact when the text in the document is changed, and does not have to be re-embedded.

In order to further clarify this distinction, applicants have amended claims **38** and **48** to include the limitation that the control mark does not have to be re-embedded in the document when the body of the document is changed by the document word processor.

The rejections of claims **38** - **57** in Paragraphs 11 - 35 of the Office Action will now be dealt with specifically.

As to amended independent method claim **38**, applicants respectfully submit that the limitation in claim **38** of

*"embedding a control mark within an electronic document created by a document word processor, such that when a body of the document is changed by the document word processor after the control mark is embedded in the document, the control mark remains embedded in the document **without having to re-embed the control mark in the document**, and wherein the control mark cannot be changed or removed by means of the document word processor"*

is neither shown nor suggested in Ng, Shaikh and Levy.

In rejecting claim **38** in paragraph 13 of the Office Action, the Examiner has cited Shaikh as disclosing a control mark that cannot be changed or removed by the electronic document. Applicants note that Shaikh, col. 1, lines 57 - 61, recites *"Authenticity of the electronic stamp can be assured by storing the document in a form that prevents further modification and/or with access limited to purposes other*

than making any further changes to the image constituting the stored form of the document.” As such, no portion of the stored document in Shaikh may be changed. In distinction, in the claimed invention the body of the electronic document may be changed by the document word processor after the control mark is embedded in the document, and nevertheless the control mark remains embedded in the document.

Because claims **39 – 47** depend from claim **38** and include additional features, applicants respectfully submit that claims **39 – 47** are not anticipated or rendered obvious by Ng, Shaikh, Levy or a combination of Ng, Shaikh and Levy.

Accordingly claims **38 – 47** are deemed to be allowable.

As to amended independent claim **48** for a computer readable storage medium, applicants respectfully submit that the limitation in claim **48** of

*“an auto-marking module for embedding a control mark within an electronic document created by a document word processor, such that when a body of the document is changed by the document word processor after the control mark is embedded in the document, the control mark remains embedded in the document **without having to re-embed the control mark in the document**, and wherein the control mark cannot be changed or removed by means of the document word processor”*

is neither shown nor suggested in Ng, Shaikh and Levy, as explained hereinabove.

Because claims **49 – 57** depend from claim **48** and include additional features, applicants respectfully submit that claims **49 – 57** are not anticipated or rendered obvious by Ng, Shaikh, Levy or a combination of Ng, Shaikh and Levy.

Accordingly claims **48 – 57** are deemed to be allowable.

Support for Amended Claims in Original Specification

Independent method claim **38** has been amended to include the limitation that the control mark does not have to be re-embedded in the document when the body of the document is changed by the document word processor. This limitation is supported in the original specification at least by page 8, lines 15 – 23, where it is explained that the control mark is embedded as a property that remains static *“regardless of how the document is edited by a document editor”*.

Independent system claim **48** has been amended to include the limitation that the control mark does not have to be re-embedded in the document when the body of the document is changed by the document word processor. This limitation is supported in the original specification at least by page 8, lines 15 – 23, where it is explained that the control mark is embedded as a property that remains static *“regardless of how the document is edited by a document editor”*.

For the foregoing reasons, applicants respectfully submit that the applicable objections and rejections have been overcome and that the claims are in condition for allowance.

Respectfully submitted,

Date: July 19, 2011

By: /Dawn-Marie Bey -44,442/

KING & SPALDING LLP

Dawn-Marie Bey

1700 Pennsylvania Avenue, N.W.

Registration No. 44,442

Suite 200

Washington, D.C. 20006

(202) 626-8978